

REMARKS

Claims Status

Claims 1, 2, 4-9 and 11-14 are pending. Claims 1, 13 and 14 are currently amended. Claims 3 and 10 were previously canceled without prejudice. Claims 2, 4-9, 11 and 12 remain as previously presented. Claims 1, 13 and 14 are amended to include a glass transition temperature (Tg) limitation of the claimed water-soluble copolymer which finds support in the examples of the specification (i.e., copolymers 1-3) as well as the Declaration submitted herewith by Dr. Boeckh. The Declaration provides the Tg values of 2 copolymers and 1 terpolymer that parallel those recited in the specification on page 16. Claim 13 is also amended to limit the C₁₋₂₂ alkyl of R³ to C₁₋₄ alkyl pursuant to page 3, line 34, of the specification. Claim 14 is also amended to remove C₁₋₂₂ alkyl of R³ as the narrower C₁₋₄ alkyl is already recited pursuant to a previous amendment. No new matter is believed to have been entered.

§102(b)/§103(a) Rejection over *Galleguillos*

Claims 1, 2, 4-9 and 11-14 are rejected as anticipated by or, in the alternative, as obvious over *Galleguillos*. Applicants respectfully traverse this rejection.

Applicants previously argued, in part, the following with respect to *Galleguillos*:

“An important way in which the present invention as claimed is distinguished over the *Galleguillos* patent is that the monomers from which the copolymer product of the reference is formed results in a copolymer that has a Tg that is greater than about 50°C (see column 4, lines 43-46 and column 7, lines 20-26). On the other hand, the presence of polyalkyleneoxide monomers in the present composition is relatively high as indicated by the content range of 60 to 99%. At these content levels of the polyalkyleneoxide monomer, the glass transition temperature of a given product would be significantly less than 50°C.” (Amendment filed August 18, 2009; page 9 – emphasis original).

In response to such arguments, the Office asserts:

“Applicant argues that Galleguillos et al, U.S. Patent No. 6,361,768, requires a copolymer that has a Tg that is greater than about 50 degrees Celsius. Although the examiner agrees with applicant on this point, the examiner respectfully asserts that the instant claims, as presently written, do not have a requirement for the glass transition temperature of the copolymer.” (Office Action, page 3, 3rd full paragraph – emphasis added).

At the outset, Applicants point out that the Office’s insinuation that an improved property of the claimed invention (in this case a lowered Tg value) must be included in the body of the claims to be examined/considered relevant to patentability has **no legal basis**. Quite the opposite, the MPEP explains how *evidence*, not claim limitations, of improved properties can rebut a *prima facie* case of obviousness (see MPEP 716.02(a)). In light of the foregoing, Applicants submit that the current Office Action, which is a first Office Action after the filing of an RCE, was **erroneously made Final**. Accordingly, Applicants respectfully request entry and consideration of this Amendment, as well as the accompanying Declaration, since (1) the Finality of the outstanding Office Action was made erroneously, and/or (2) it was not apparent until the mailing of the current Office Action that the provision to the Office of the Tg values of the copolymers of the specification would be needed in order to obtain complete examination and consideration of Applicants’ previously filed arguments.

Notwithstanding the above and despite the lack of a requirement that such improved properties be expressly recited in the claims, Applicants have included the recitation of such a property in independent claims 1, 13 and 14 in light of the Office’s current assertions that the “examiner agrees with applicant on this point,” namely with respect to the differing Tg values.

Accordingly, as the Office has already agreed with the Applicants that the Tg values of the claimed invention, as compared to *Galleguillos*, are significantly different, Applicants request withdrawal of the anticipation rejection over *Galleguillos*. Furthermore, as the copolymers of *Galleguillos* are said to have Tg values greater than about 50°C, Applicants

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submit that *Galleguillos* fails to disclose or suggest copolymers having Tg values of no more than -48°C as recited by the claimed invention. In light of *Galleguillos'* failure to disclose or suggest copolymers having such low Tg values as those claimed, Applicants submit that *Galleguillos* can not and does not render obvious the claimed invention. Accordingly, Applicants request withdrawal of the obviousness rejection over *Galleguillos*.

§102(e)/§103(a) Rejection over *Morschhauser*

Claims 13 and 14 are rejected as anticipated by or, in the alternative, as obvious over *Morschhauser*. Applicants respectfully traverse this rejection.

As noted by the Office in the outstanding Office Action (page 4, 2nd full paragraph), the Office previously withdrew a §102(e)/§103(a) rejection over *Morschhauser* of claims 1-9, 11 and 12 pursuant to an amendment of these claims limiting the alkyl group of R³ to a C₁₋₄ alkyl rather than the broader C₁₋₂₂ alkyl. However, the Office notes that the current rejection over *Morschhauser* of claims 13 and 14 remains because R³ of these claims was not so limited. Applicants submit that claims 13 and 14 now limit the alkyl group of R³ to a C₁₋₄ alkyl group. Accordingly, Applicants request withdrawal of the rejection over *Morschhauser* of claims 13 and 14, as was previously done with claims 1-9, 11 and 12, and for the same reasons as applied to claims 1-9, 11 and 12.

Conclusion

Applicants submit that all now-pending claims are in condition for allowance.

Applicants respectfully request the withdrawal of this rejection and passage of this case to issue.

Respectfully submitted,

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